

REMARKS

(A) STATUS OF THE APPLICATION

Applicants thank the Examiner for his explanation of the rejections in the Non-Final Office Action dated June 07, 2007.

(I) DISPOSITION OF CLAIMS

- (i) Claims 1-32 are pending in the application.
- (ii) Claims 1, 3, 4, 18, & 20-32 are withdrawn from consideration.
- (iii) Claims 2, 5-17, & 19 are rejected under 35 U.S.C. § 103(a).

(II) APPLICANTS' ACTION

- (i) Applicants have amended Claim 2. No new matter was added.
- (ii) Applicants have added new Claims 33 & 34. No new matter was added.
- (iii) Applicants also respond to the above rejections.
- (iv) Applicants submit declarations from Dr. Ming Zheng and Dr. Xueying Huang, under 37 C.F.R. § 131, with Exhibits, 1, 2, and 3H-8H.

In the ensuing discussion, comments under the sub-heading "Examiner Comment X" are attributed to the Examiner. Unless specified, Applicants may not generally agree with the assertions made by the Examiner under that sub-heading. Applicants give their views in the comments under the sub-heading "Applicants' Response to Examiner Comment X."

(B) RESPONSE TO REJECTION UNDER 35 U.S.C. § 103(A)

TEMPLETON, ET AL. IN VIEW OF FOOS, ET AL.—CLAIMS 2, 5-17, & 19

Pursuant to 35 U.S.C. § 103(a), the Examiner rejects Claims 2, 5-17, and 19 as being unpatentable over Templeton, *et al.*, *Langmuir* 1999, 15, pg. 66-76 (*hereinafter* "Templeton") in view of Foos, *et al.*, *Chem. Mater.* 2002, 14, 2401-2408 (*hereinafter* "Foos").

Applicants had filed a declaration under 37 C.F.R. § 131 (*hereinafter* “131 declaration”) in response to the previous Office Actions pertaining to the same 35 U.S.C. § 103(a) obviousness rejection. Said declaration does not overcome the 35 U.S.C. § 103(a) obviousness rejection because of the reasons listed below. Applicants respectfully disagree and respond, point-by-point, directly under the Examiner’s comments.

EXAMINER COMMENT 1

Two persons are listed as inventors on the subject patent application, Dr. Ming Zheng and Dr. Xueying Huang. Under 37 C.F.R. § 1.131, all inventors of the subject matter of the rejected claims must sign the 131 declaration. However, only Dr. Ming Zheng’s declaration was submitted.

APPLICANTS’ RESPONSE TO COMMENT 1

Accompanying this response, Applicants submit 131 declarations from each of the inventors, Dr. Ming Zheng and Dr. Xueying Huang.

EXAMINER COMMENT 2

The 131 declaration does not contain “an allegation that the acts relied upon to establish the date prior to the reference” were performed in the United States.

APPLICANTS’ RESPONSE TO COMMENT 2

The newly submitted 131 declarations are amended to include such an “allegation. Please see Dr. Ming Zheng’s declaration, Page 1, Clause 3; Page 2, Clause 4; Page 2, Clause 6; and Dr. Xueying Huang’s declaration, Page 1-2, Clause 4; Page 2, Clause 6; and Page 2-3, Clause 8.

EXAMINER COMMENT 3

The 131 declaration does not clearly explain the facts or data that the Applicants are relying on to show that their invention was completed before a particular date. Particularly, the declaration does not show that “water concentration of 9-18% VV in reaction mixture,” an element of independent Claim 2, was performed prior to the effective date of the Foos reference.

APPLICANTS’ RESPONSE TO COMMENT 3

The newly submitted 131 declarations address this question. Particularly, please see Dr. Ming Zheng’s 131 declaration on Page 2 Clause 6 (or Dr. Xueying Huang’s 131 declaration on same subject matter on Page 2, Clause 8). Said Clauses 6 and 8 describe in detail why the subject patent application’s invention was completed prior to the effective date of the Foos reference.

Applicants have also amended Claim 2, in that said “water concentration” element is now deleted from Claim 2. Thus, the issue of antedating said element is now moot. Applicants also submit that Foos does not relate to the “direct synthesis” method in which said “water concentration” element is implicated. Foos relates to “ligand exchange” reactions, wherein said “water concentration” element is redundant. Therefore, whether or not said element antedates the Foos reference, is moot.

Secondly, Applicants note (in the 131 declarations) that said “water concentration” element relates to the optimization of Applicants’ process, which in and of itself is novel. It is in fact a preferred condition for operating the process of Applicants’ invention. For convenience, Applicants have added two new claims, Claim 33 and Claim 34, dependent on independent Claim 2, pertaining to this particular element. Please see Dr. Ming Zheng’s 131 declaration, Page 3, Clause 6, last paragraph.

EXAMINER COMMENT 4

The declaration does not show a reduction to practice of all coated metallic nanoparticles, only of a few.

APPLICANTS' RESPONSE TO COMMENT 4

This point is addressed in the 131 declaration. Please see Dr. Ming Zheng's 131 declaration on Page 4-5, Clause 7.

EXAMINER COMMENT 5

The provisional patent application of the present invention does not fully support the independent Claim 2. Particularly, the provisional does not teach a shielding coating component having a metal binding functionality. It only teaches ethylene glycol having metal binding functionality.

APPLICANTS' RESPONSE TO COMMENT 5

Applicants respectfully disagree. First, ethylene glycol is a shielding coating component. Second, "shielding coating component" is defined in the provisional patent application on Page 5, Lines 1-5 (which also state that ethylene glycol is a preferred shielding coating component).

Applicants respectfully submit that in light of the above comments and the newly submitted 131 declarations, said claims are not obvious under 35 U.S.C. § 103(a).

(C) AMENDMENT OF ERROR IN PREVIOUSLY SUBMITTED 37 C.F.R. § 131 DECLARATION

Applicant Dr. Ming Zheng submits that in his previously filed 131 declaration dated December 03, 2006, he had erroneously asserted that Exhibit 2 attached to said 131 declaration relates to the "direct synthesis" method of making gold nanoparticles. Applicant Dr. Ming Zheng hereby submits, by way of the new 131 declaration, that said assertion was made in error. Applicant further correctly asserts (by way of the new and amended 131 declaration) that Exhibit 2 relates to "ligand exchange" reactions. Please see Dr. Ming Zheng's 131 declaration, Page 3, Clause 6.

CONCLUSION

In view of the above remarks, Applicants respectfully submit that the stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Non-Final Office Action mailed on June 07, 2007.

Therefore, Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited.

If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E. I. du Pont de Nemours & Co.).

RESPECTFULLY SUBMITTED,

BY:

Date: SEPTEMBER 27, 2007

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